

Response Dated: February 18, 2005
Response to Office Action of November 18, 2004

Application No. 10/056,674

REMARKS

The Office Action of November 18, 2004 has been reviewed and the comments therein were carefully considered. Claims 1-25 are pending in this application and have been rejected.

Double Patenting Provisional Rejection

Claims 1-3, 10-13, 21, 23 and 25 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1-3, 9-11, 14, 20, 24 and 29 of co-pending U.S. Application No. 09/966,042.

The Office Action acknowledges that "the conflicting claims are not identical." However, the Office Action goes on to allege that the conflicting claims "are not patentably distinct from each other" The Applicant respectfully disagrees with this assertion. Indeed, the present application expands upon the subject matter included in U.S. Application No. 09/966,042 in a patentably distinct manner. Specifically, claims 1, 21, 23 and 25 of the present application, for example, include the feature of "sorting the plurality of messages into a set of groups in accordance with . . . a first context category" and "representing the icons [associated with those messages] on the display in accordance with the sorting"

By contrast, U.S. Application No. 09/966,042 describes "representing . . . a first icon . . . that best match[es] the one or more context values" As apparently acknowledged by the Office Action,¹ there is no disclosure in U.S. Application No. 09/966,042 of sorting messages into a set of groups in accordance with a context category. This additional feature of the claims in the present application in itself makes those claims patentably distinct.

¹ Specifically, the Applicant refers to the statement in the Office Action that "[c]laims 1, 21, 23 & 25 however state a sorting method icon, which is not disclosed in application 09/966,042."

Response Dated: February 18, 2005
Response to Office Action of November 18, 2004

Application No. 10/056,674

Moreover, because U.S. Application No. 09/966,042 does not disclose such sorting, it follows that U.S. Application No. 09/966,042 also does not disclose or claim a method or system that represents icons in accordance with such sorting as claimed in the present application. Therefore, the claims of the present application are patentably distinct for this reason as well. Claims 1-3, 9-11, 14, 20, 24 and 29 in U.S. Application No. 09/966,042 were cited in the Office Action because of their teachings relating to representing icons. While it is true that U.S. Application No. 09/966,042 does teach representing icons, it does not disclose nor claim a method or system of representing icons in multiple groups sorted in accordance with a context category.

Accordingly, the Applicant submits that each one of the independent claims pending in the present application includes features not disclosed or claimed in U.S. Application No. 09/966,042. Transitively, each one of the dependent claims pending in the present application includes features not disclosed or claimed in U.S. Application No. 09/966,042. For at least these reasons, the Applicant respectfully requests withdrawal of the double patenting rejection of claims 1-3, 10-13, 21, 23 and 25.

Rejection under 35 USC §112:

Claim 23 stands rejected under 35 USC §112 as lacking antecedent basis. Applicant has amended Claim 23 to overcome this rejection.

Rejection under 35 USC §103 (a):

Claims 1-25 stand rejected under 35 USC §103(a) as being unpatentable over Dowling et al. (U.S. Patent No. 6,522,875) in view of Shulman et al. (U.S. Application No. 2001/00330664). The Applicant respectfully traverses this rejection.

Response Dated: February 18, 2005
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Application No. 10/056,674

The cited documents, either alone or in combination, do not disclose, teach or suggest the invention claimed in claims 1, 21, 23 and 25. In particular, claims 1, 21, 23 and 25 include the feature of "sorting the plurality of messages into a set of groups in accordance with one or more characteristics associated with each of the plurality of messages and a first context category." The Office Action indicates that Dowling teaches or suggests such sorting. (Dowling, Col. 4, ll. 15-20) ("a packet filter is configured to selectively pass packets according to a predefined criterion. When a packet passes through the packet filter, a web site is automatically accessed."). The Office Action also argues that "[t]he packet filter [in Dowling] is a forming of sorting information that is being received to the hand-held device. The sorting is preformed on the hand-held device, and packet filter is configured to display information only those characteristics are associated with user, and will create categories if plurality of packets are received in a geographic area."

However, Applicant respectfully disagrees that the "packet filter" in Dowling teaches or suggests sorting messages "into a set of groups." In particular, the "packet filter" merely allows or denies packets into a geographical web browser. The "packet filter" does not sort allowed packets, or denied packets, into groups. This feature is also not found in Shulman or in any of the remaining prior art of record. For at least this reason, the Applicant respectfully submits that claims 1, 21, 23 and 25 are patentable over any conceivable combination of Dowling, Shulman and the remaining prior art of record. Claims 2-20, 22 and 24 depend from claims 1, 21 and 23 and thus are allowable for at least the same reasons.

In addition, with regard to dependent Claim 4, the Office Action states that Dowling in view of Shulman discloses the feature of "representing the groups in distinct sections of the display (paragraph 50 lines 1-4) [An aspect of the SmartIcon 192 can be similar to modern weather alert warnings or station identification icons, which are generally displayed in a corner of the television

Response Dated: February 18, 2005
Response to Office Action of November 18, 2004

Application No. 10/056,674

screen.].” However, the passage in Shulman cited by the Office Action does not teach the feature of representing **multiple groups in distinct sections** of the display. Claim 5 depends from Claim 4 and thus is allowable for at least the same reasons.

With regard to dependent Claim 6, the Office Action states that Dowling in view of Shulman discloses the feature of having “sizes of each of the icons within each group correspond to the sorting performed in (c) (paragraph 9 lines 11-17) [Intermittence levels determine what interval for the SmartIcon to intermittently persist, a transparency level determines opaqueness of the SmartIcon, and a size level determines the display size of the SmartIcon.].” However, the passage in Shulman cited by the Office Action does not teach the feature of sizing icons **in accordance with a sorting procedure**. Claim 7 depends from Claim 6 and thus is allowable for at least the same reasons.

With regard to dependent Claim 10, the Office Action states that Dowling in view of Shulman discloses the feature of “extracting an icon from one of the plurality of messages (paragraph 10 lines 1-3) [Another aspect of the present invention relates to generating an icon. A subscriber device receives notification and it is determined if an icon is to be displayed in response to the received notification.].” However, the passage in Shulman cited by the Office Action teaches the feature of **generating an icon, not extracting an icon from a message**.

With regard to dependent claims 22 and 24, the Office Action states that Dowling in view of Shulman discloses the feature of “a context category database storing context category values (paragraph 55 lines 17-19) [SmartIcon 192 and a shape level 365 determines the SmartIcon 192 image/shape for display].” However, the passage in Shulman cited by the Office Action teaches the feature of **a database of icons and “shape levels,” not a database of context category values**.

Response Dated: February 18, 2005
Response to Office Action of November 18, 2004

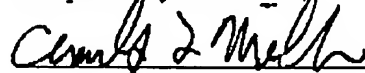
Application No. 10/056,674

CONCLUSION

The Applicants respectfully submit that the instant application is in condition for allowance. Should the Examiner believe that a conversation with Applicant's representative would be useful in the prosecution of this case, the Examiner is invited and encouraged to call Applicant's representative.

Dated: February 18, 2005

Respectfully submitted,



Charles L. Miller
Registration No. 43,805
BANNER & WITCOFF, LTD.
10 South Wacker Drive
Chicago, Illinois 60606
Telephone: 312-463-5000
Facsimile: 312-463-5001